

REMARKS

The Office Action has withdrawn the allowance of claim 67. In addition, it has indicated that it does not believe that claims 70 and 73-84, which were indicated to be allowable by the previous Examiner, are allowable. The Office Action basically restarted prosecution and imposed a restriction requirement under 35 U.S.C. §121, alleging that the application contains two patentability distinct inventions, as follows:

- I. Claim 67, drawn to a solid substance, classified in class 428, subclass 367.
- II. Claims 70 and 73-84, drawn to an electron emissive material, classified in class 423, subclass 447.2.

In support of the restriction requirement, the Office Action has alleged that Groups I and II are related as combination and sub-combination. The Office Action requests that applicants elect a group for continued prosecution.

Before addressing the merits of the issues raised in the Official Action, it should be noted that applicants have added claims 97-107 to the application. The added claims are supported by the specification. In fact, the added claims are directed to subject matter that was deleted in the previous amendment dated September 7, 2005. The subject matter deleted in the previous response was not abandoned but was deleted solely for the purpose of putting the application in a condition which the United States Patent and Trademark Office considered allowable. Since the United States Patent and Trademark Office has now changed its position, applicants are entitled to add this subject matter back into the application.

Support for claims 97-107 is found in original claims 68, 69, 71, 72, 80, 81, 85, 86, 87, 88 and 89, respectively.

No new matter is added to the application.

Applicants elect, with traverse, the subject matter of Group II, i.e., claims 68 et seq for continued examination herein. Applicants, however, reserve the right to file a divisional application directed to the non-elected subject matter.

Notwithstanding the foregoing, applicants hereby traverse, pursuant to 37 C.F.R. §§1.111 and 1.143, the requirement for restriction and request reconsideration thereof in view of the following remarks.

Applicants respectfully request that the Restriction Requirement be withdrawn since it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §§1.141 and 1.142.

35 U.S.C. §121 provides that the Commissioner may restrict an application when two or more independent and distinct inventions are claimed in a single application (emphasis added). Similarly, 37 C.F.R. §1.141(a) permits restriction on condition that independent and distinct inventions are found within one application. Only the statutory requirement that the various groups are “distinct” has been proffered as a basis for requiring the restriction. Even assuming, pro arguendo, that the Office Action was correct with respect to distinctiveness, there is absolutely no indication in the Office Action that Groups I and II are also independent. In fact, applicants submit that there is an interdependence between each of the groups alleged to be patentably distinct.

MPEP §802.01 defines independent as follows:

The term “independent” (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is they are un connected in design, operation or effect...

Applicants respectfully submit that the subject matter in Groups I and II are connected in design, operation or effect and are thus not dependent. More specifically,

Group I is directed to a material comprised of by more than over half by weight of carbon nanotubes having walls consisting essentially of two layers of carbon atoms (double walled nanotubes). Group II is directed to the electron-emissive material comprising the double walled nanotubes. Consequently, both Groups I and II encompass compositions containing double walled nanotubes. Thus, there is a disclosed relationship between the groups. Consequently, because the Office Action has not even alleged the statutory required "independence" of these groups and further because these groups of claims are connected in design, operation and/or effect and are therefore not independent, the claims which the Office Action has grouped separately are not "independent and distinct", so as to justify the Restriction Requirement. It is therefore respectfully submitted that the Restriction Requirement is improper and cannot be maintained.

Moreover, the Office Action alleges that the searches for the alleged two groups are distinct, implying that they are in different classes, thereby making the search of both groups too burdensome.

However, the United States Patent and Trademark Office has already conducted a search. The United States Patent and Trademark Office has issued three substantive Office Actions, in which it has conducted a search on the subject matter that is present in the above-identified application prior to the imposition of the restriction requirement in the outstanding Office Action. Thus, it is not too burdensome for the United States Patent and Trademark Office to update a search which it has already conducted.

Moreover, such suggestion that a prior art search requiring search in more than one classification is sufficient criteria for maintaining a restriction to allegedly different

patentable inventions is in error. It simply does not comply with the provisions under 35 U.S.C. §121. (See In re Kuehl, *infra*).

The classification system is an unreliable basis for requiring restriction between claims to the various aspects of applicants' unitary invention, because the system exhibits considerable overlap in technical definitions. In particular, the definitions of subclasses in the classification system do not prevent an Examiner from basing patentability decisions, as to claims he assigned to one group, on patent references found in the subclass(es) with which he associated another group of claims.

Furthermore, the classification system is a poor basis for requiring restriction between related aspects of an invention because classifications and definitions change over time. Thus, a classification that might have seemed to support restriction at a given time could change, thereby casting a shadow over the propriety of the restriction requirement later on during the term of the patents issuing from parent and divisional applications. Indeed, classifications seem largely to change in response to considerations of administrative convenience, and often in response to nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with whether the subject matter of patents assigned to different classifications is "independent and distinct" as those terms are used in 35 U.S.C. §121, which fact proves that basing restriction requirements on the classification system is improper.

In addition, the courts have recognized that it is in the public interest to permit an applicant to claim several aspects of his invention together in one application, as the applicant has done herein, so as to encourage the applicant to provide a more detailed disclosure of all aspects of their invention. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner recognized by 35 U.S.C. §112, all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of applicant's financial resources, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive and thereby contravenes the constitutional intent to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), applicants are required to either conduct simultaneous prosecution with attendant filing fees and costs or face a compromise of the term of their patent assets.

It is vital to all applicants that Restriction Requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double-patenting. The third sentence of U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention-double-patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), that court held that §121 does not insulate a patentee from an allegation of "obviousness-

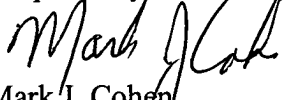
type” double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which applicant’s legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect patentee’s rights and to serve the public’s interest in the legitimacy of issued patents, applicant respectfully urges the Examiner not to require restriction in cases such as the present application.

Moreover, it is to be noted that the imposition of a new restriction requirement after five years from the filing of the application prolongs the prosecution of the present application beyond the desired three years set forth in 35 U.S.C. §154(b)(B).

Hence, it is respectfully requested that the United States Patent and Trademark Office reconsider and withdraw the requirement for restriction pursuant to 35 U.S.C. §121 and provide an action on the merits with respect to all of the claimed subject matter.

Respectfully submitted,


Mark J. Cohen
Registration No. 32,211

Scully, Scott, Murphy & Presser
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343

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